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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,626	10/11/2001	Robert E. Haines	10007582-1	1665
7590 03/25/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			EXAMINER MEUCCI, MICHAEL D	
			ART UNIT	PAPER NUMBER
			2442	
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			03/25/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/976,626

Applicant(s)

HAINES ET AL.

Examiner

MICHAEL D. MEUCCI

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-16, 18-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, 18-23 and 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the appeal brief filed 25 August 2008.
2. Claims 1-8, 10-16, 18-23, and 25-35 are pending.
3. Claims 9, 17, and 24 are cancelled.

In view of the appeal brief conference decision on 13 February 2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, Applicant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then Applicant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below. Because new grounds of rejection are being made, this action is non-final.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 27-35 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. For example, the steps disclosed in claims 27-35 are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. Additionally, the steps disclosed in claims 27-35 may be implemented in software alone and are therefore not tied to a particular machine.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gecht et al. (U.S. 6,859,832 B1) hereinafter referred to as Gecht, in view of Leon (U.S. 2001/0042052 A1).

a. Regarding claim 1, Gecht teaches: receiving an electronic message including hard copy output engine configuration data (line 61 of column 11 through line 16 of column 12) through a firewall (lines 9-10 of column 12), wherein the electronic message transmitted through the firewall designates a hardcopy output engine to be configured (line 61 of column 11 through line 4 of column 12); and configuring the hard copy output engine using the hard copy output engine configuration data (lines 5-9 of column 12).

Gecht does not explicitly teach: receiving the configuration data from an undesignated website. However, Leon discloses: and "One of the servers 114 may also be configured to control the downloading of printer control programs from PVS 102 to user system 104," (paragraph [0085] on page 6). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to receive the configuration data from an undesignated website. "As previously stated, these web pages allow a user to interact with PVS 102. e.g. to configure requests to PVS 102 to purchase postage, or to subscribe to postage products. When user system 104 requests communication with PVS 102, one of servers 114 may be configured to establish a communication link between user system 104 and PVS 102," (paragraph [0085] on page 6 of Leon). It is for this reason that one of ordinary skill in the art at the

time of the applicant's invention would have been motivated to receive the configuration data from an undesignated website in the system as taught by Gecht.

b. Regarding claim 6, Gecht teaches: the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers, and printers (lines 37-50 of column 7).

c. Regarding claim 7, Gecht teaches: wherein the configuration data include data prepared by: determining a make and model for the hard copy output engine (lines 14-15 of column 11); determining a serial number for the hard copy output engine (lines 11-16 of column 12); and determining user thresholds for consumables associated with the hard copy output engine (lines 45-59 of column 8).

8. Claims 2-5, 8, 10-16, 18-23, and 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gecht and Leon, in view of Kaufman et al. (U.S. 7,126,716 B1) hereinafter referred to as Kaufman.

a. Regarding claims 2 and 3, Gecht teaches: wherein configuring comprises configuring the hard copy output engine using the hard copy output engine configuration data (lines 5-9 of column 12).

Gecht does not explicitly teach an embedded web server contained in the hard copy output engine; and wherein receiving the electronic message comprises receiving an email at the hard copy output engine.

Regarding the embedded web server, Leon discloses: "One of the servers 114 is responsible for receiving URL requests from user systems 104 and for forwarding web

pages corresponding to the URL requests to the requesting user systems 104," (paragraph [0085] on page 6). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to configure the hard copy output engine via an embedded web server contained in the hard copy output engine. "As previously stated, these web pages allow a user to interact with PVS 102. e.g. to configure requests to PVS 102 to purchase postage, or to subscribe to postage products. When user system 104 requests communication with PVS 102, one of servers 114 may be configured to establish a communication link between user system 104 and PVS 102," (paragraph [0085] on page 6 of Leon). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to configure the hard copy output engine via an embedded web server contained in the hard copy output engine in the system as taught by Gecht.

Regarding receiving the electronic message comprises receiving an email at the hard copy output engine, Kaufman discloses: "As discussed above, preferably the printer 10 is configured such that the printer 10 can interface with a device at a remote location via e-mail or TCP/UDP over an Intranet, the Internet or over a wireless communication network," (lines 29-33 of column 6). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to have receiving the electronic message comprise receiving an email at the hard copy output engine. "As described above, preferably the printer 10 is configured to display web pages over an Intranet, the Internet or over a wireless communication network. Preferably, one of the web pages is configured such that the user can select conditions (such as printer error

or warning conditions) of which the user wants to be alerted, and can select how he or she wants to be alerted," (lines 34-40 of column 6 in Kaufman). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have receiving the electronic message comprise receiving an email at the hard copy output engine in the system as taught by Gecht and Leon.

b. Regarding claims 4 and 11, while Gecht teaches: receiving a message through the firewall at a first user station (lines 9-10 of column 12); and forwarding the message to the hard copy output engine (lines 34-39 of column 12), Gecht does not explicitly teach that the message is an e-mail. However, Kaufman discloses: "As discussed above, preferably the printer 10 is configured such that the printer 10 can interface with a device at a remote location via e-mail or TCP/UDP over an Intranet, the Internet or over a wireless communication network," (lines 29-33 of column 6). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to have receiving the electronic message comprise receiving an email. "As described above, preferably the printer 10 is configured to display web pages over an Intranet, the Internet or over a wireless communication network. Preferably, one of the web pages is configured such that the user can select conditions (such as printer error or warning conditions) of which the user wants to be alerted, and can select how he or she wants to be alerted," (lines 34-40 of column 6 in Kaufman). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have receiving the electronic message comprise receiving an email in the system as taught by Gecht and Leon.

c. Regarding claim 5, Gecht teaches: configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print: media consumed (lines 34-47 of column 12).

Gecht does not explicitly teach: wherein receiving the electronic message comprises receiving an XML script. However, Kaufman discloses: "Preferably, as shown in FIG. 4, the printer 10 is configured such that a user 180 can upload the printer's settings in a format such as XML, can view and modify the settings using a web browser, and can thereafter download the settings back to the printer 10, or to other printers (10a, 10b, 10c, etc.) in the network to facilitate cloning," (lines 14-19 of column 7). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to have receiving the electronic message comprise receiving an XML script. "Preferably, the printer is configured to transmit its settings to a remote location in XML format so that the printer settings are easy to read and are viewable using, for example, a web browser on a personal computer connected to the Intranet or the Internet," (lines 57-61 of column 3 in Kaufman). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have receiving the electronic message comprise receiving an XML script in the system as taught by Gecht and Leon.

d. Regarding claim 8, Gecht teaches: a device configured to provide a computer instruction signal embodied in a carrier wave carrying instructions that when executed by a processor cause the processor to: receive an electronic message

including hard copy output engine configuration data (line 61 of column 11 through line 16 of column 12) through a firewall (lines 9-10 of column 12); and configure the hard copy output engine using the configuration data (lines 5-9 of column 12).

Gecht does not explicitly teach: receiving the electronic message from an undesignated website; wherein the message received is an email; and an embedded web server contained in the hard copy output engine.

Regarding receiving the electronic message from an undesignated website, Leon discloses: and "One of the servers 114 may also be configured to control the downloading of printer control programs from PVS 102 to user system 104," (paragraph [0085] on page 6). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to receive the electronic message from an undesignated website. "As previously stated, these web pages allow a user to interact with PVS 102. e.g. to configure requests to PVS 102 to purchase postage, or to subscribe to postage products. When user system 104 requests communication with PVS 102, one of servers 114 may be configured to establish a communication link between user system 104 and PVS 102," (paragraph [0085] on page 6 of Leon). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to receive the electronic message from an undesignated website in the system as taught by Gecht.

Regarding wherein the message is an email, Kaufman discloses: "As discussed above, preferably the printer 10 is configured such that the printer 10 can interface with a device at a remote location via e-mail or TCP/UDP over an Intranet, the Internet or

over a wireless communication network," (lines 29-33 of column 6). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to have the message comprise an email. "As described above, preferably the printer 10 is configured to display web pages over an Intranet, the Internet or over a wireless communication network. Preferably, one of the web pages is configured such that the user can select conditions (such as printer error or warning conditions) of which the user wants to be alerted, and can select how he or she wants to be alerted," (lines 34-40 of column 6 in Kaufman). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have the message comprise an email in the system as taught by Gecht and Leon.

Regarding the embedded web server, Leon discloses: "One of the servers 114 is responsible for receiving URL requests from user systems 104 and for forwarding web pages corresponding to the URL requests to the requesting user systems 104," (paragraph [0085] on page 6). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to configure the hard copy output engine via an embedded web server contained in the hard copy output engine. "As previously stated, these web pages allow a user to interact with PVS 102. e.g. to configure requests to PVS 102 to purchase postage, or to subscribe to postage products. When user system 104 requests communication with PVS 102, one of servers 114 may be configured to establish a communication link between user system 104 and PVS 102," (paragraph [0085] on page 6 of Leon). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to configure

the hard copy output engine via an embedded web server contained in the hard copy output engine in the system as taught by Gecht and Leon.

e. Regarding claim 10, while Gecht teaches: computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive a message (line 61 of column 11 through line 16 of column 12) through the firewall (lines 9-10 of column 12), Gecht does not explicitly teach: the message is an e-mail. However, Kaufman discloses: "As discussed above, preferably the printer 10 is configured such that the printer 10 can interface with a device at a remote location via e-mail or TCP/UDP over an Intranet, the Internet or over a wireless communication network," (lines 29-33 of column 6). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to have the message comprise an email. "As described above, preferably the printer 10 is configured to display web pages over an Intranet, the Internet or over a wireless communication network. Preferably, one of the web pages is configured such that the user can select conditions (such as printer error or warning conditions) of which the user wants to be alerted, and can select how he or she wants to be alerted," (lines 34-40 of column 6 in Kaufman). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have the message comprise an email in the system as taught by Gecht and Leon.

f. Regarding claim 12, Gecht teaches: configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print: media consumed (lines 34-47 of column 12).

g. Regarding claim 13, Gecht teaches: the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers, and printers (lines 37-50 of column 7).

Gecht does not explicitly teach: wherein receiving the electronic message comprises receiving an XML script; and wherein the hard copy output engine is chosen from a group consisting of facsimile machines, photocopiers, and printer. However, Kaufman discloses: "Preferably, as shown in FIG. 4, the printer 10 is configured such that a user 180 can upload the printer's settings in a format such as XML, can view and modify the settings using a web browser, and can thereafter download the settings back to the printer 10, or to other printers (10a, 10b, 10c, etc.) in the network to facilitate cloning," (lines 14-19 of column 7). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to have receiving the electronic message comprise receiving an XML script. "Preferably, the printer is configured to transmit its settings to a remote location in XML format so that the printer settings are easy to read and are viewable using, for example, a web browser on a personal computer connected to the Intranet or the Internet," (lines 57-61 of column 3 in Kaufman). It is for this reason that one of ordinary skill in the art at the time of the

applicant's invention would have been motivated to have receiving the electronic message comprise receiving an XML script in the system as taught by Gecht and Leon.

h. Claims 14-16 and 18-20 are system-equivalents of the apparatus claims 8 and 10-13 and are rejected under the same rationale.

i. Claims 21-23, 25, and 26 are article of manufacture-equivalents of the apparatus claims 8 and 10-13 and are rejected under the same rationale.

j. Claims 27-35 are method-equivalents of the apparatus claims 8 and 10-13 and are rejected under the same rationale.

Response to Arguments

9. Applicant's arguments, see Appeal Brief, filed 15 October 2008, with respect to the rejection(s) of claim(s) 1-8, 10-16, 18-23, and 25-35 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection are made in view of Gecht, Leon, and Kaufman as detailed above.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Meucci at (571) 272-3892. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached at (571) 272-3868. The fax phone number for this Group is 571-273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.meucci@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2442